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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,881	02/04/2004	Michael A. Sanzone	1017001USIAP	3751

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EXAMINER
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KOCH, GEORGE R

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/771,881

Applicant(s)

SANZONE ET AL.

Examiner

George R. Koch III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1/19/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of group II, claims 20-38 in the reply filed on 1/19/2005 is acknowledged.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 20-22, 24-26, and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Hogerton (US 2003/0189490 A1).

Hogerton discloses a method of applying an RFID label to an item (abstract), the label having a transponder (RFID tags 66), the method comprising the steps of: positioning a label adjacent an application zone (For example, next to interrogator 100 in Figures 2-5), testing the label for viability adjacent the application zone (via interrogator 100 - see paragraph 0047, 0055, 0056); communicating the result of the test to a control circuit (see paragraph 0058, which discloses a control system for operating the sensors and motors); allowing the control circuit to communicate with a

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power supply (see paragraph 0057); and operating the power supply to move the label to the item if the label is viable (paragraph 0057).

As to claim 21, Hogerton discloses that the interrogator includes antennas (see paragraph 0045) and thus discloses the step of operating an RFID antenna adjacent the application zone to test the viability of the label.

As to claim 22, Hogerton discloses that the label is tested when the label is positioned at least partially on an applicator head (see dispensing mechanism 126 - interrogator 100 is adjacent this mechanism and tests the RFID while the label is disposed thereon as in Figures 2-5).

As to claim 24, Hogerton discloses the step of writing to the label after the test has confirmed a viable label (for example, see paragraph 0055, lines 9-14).

As to claim 25, Hogerton discloses the steps of testing information written to the label for viability of the information (see paragraph 0055, lines 14-16, which discloses verification) and applying the label to the item if the information is viable and moving the label to a reject area if the information is non-viable (see paragraphs 0055-0056).

As to claim 26, Hogerton as applied in claim 25 above discloses the step of moving the label to a reject area if the test reveals that the label is non-viable.

As to claim 34, Hogerton as applied to claims 20, 21 and 25 (see citations above) discloses a method of applying an RFID label to an item, the label having a transponder, the method comprising the steps of: positioning a label adjacent an application zone; testing the label for viability adjacent the application zone with an

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RFID antenna; and moving the label to the item if the label is viable and to a reject area if the label is non-viable.

As to claim 35, Hogerton discloses the step of writing to the label after the test has confirmed a viable label (for example, see paragraph 0055, lines 9-14).

As to claim 36, Hogerton discloses the steps of testing information written to the label for viability of the information (see paragraph 0055, lines 14-16, which discloses verification) and applying the label to the item if the information is viable and moving the label to a reject area if the information is non-viable (see paragraphs 0055-0056).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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6. Claims 23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogerton (US 2003/0189490 A1) as applied to claims 20-22, 24-26 and 34-36 above, and further in view of Hohberger (2003/0063001 A1).

As to claim 23, Hogerton does not disclose the testing step includes coupling the antenna electronically to the label through at least a portion of the applicator head.

However, Hohberger discloses that the testing step includes coupling the antenna electronically to the label through at least a portion of the applicator head. Hohberger discloses that the antenna is mounted within the applicator head (see paragraphs 0047-0051). Hohberger discloses that this operation temporarily stops the adhesion process, and ensures proper application. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such an testing mechanism and air channel in order to ensure proper RFID application.

As to claim 28, Hogerton does not disclose that the antenna is mounted within the applicator head and at least one air channel is formed in the applicator head and extends around the antenna, and wherein the method further includes the step of evacuating air from the at least one air channel after the test is complete.

Hohberger discloses that the antenna is mounted within the applicator head and at least one air channel is formed in the applicator head and extends around the antenna, and wherein the method further includes the step of evacuating air from the at least one air channel after the test is complete (see paragraphs 0047-0051). Hohberger discloses that this operation temporarily stops the adhesion process, and ensures proper application. Therefore, it would have been obvious to one of ordinary skill in the

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art at the time of the invention to have utilized such an air channel in order to ensure proper RFID application.

7. Claims 27, 29-33 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogerton (US 2003/0189490 A1) as applied to claims 20-22, 24-26 and 34-36 above, and further in view of Murphy (5,843,252).

As to claim 27, Hogerton does not disclose that the moving step includes sliding an applicator head carrying the label from a position adjacent the application zone to a position adjacent the reject area.

Murphy discloses that the moving step includes sliding an applicator head carrying the label from a position adjacent the application zone to a position adjacent the reject area (for example, column 9, lines 55-65). Murphy discloses that such a mechanism prevents the application of defective labels. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize such a reject mechanism in order to prevent the application of defective labels.

As to claim 29, Murphy as incorporated above discloses that the operating step includes the step of blowing the label to move the label to the item if the label is viable (see columns 16-17).

As to claim 30, Murphy as incorporated above discloses that the blowing step includes operating an air source to move air through air channels formed in an applicator head (see columns 16-17).

As to claim 31, Murphy as incorporated above discloses the step of moving the applicator head toward the item prior to the blowing step.

As to claim 32, Murphy as incorporated above discloses that the operating step includes suctioning the label to the applicator head prior to the blowing step (Figure 5E, columns 16-17).

As to claim 33, Murphy as incorporated above discloses that further including the step of guiding a carrier web carrying the label around a peel edge (item 108) adjacent the applicator head to separate the label from the carrier web prior to the suctioning step.

As to claim 37, Murphy as incorporated above discloses that the moving step includes the step of blowing the label to move the label to the item if the label is viable and blowing the label to move the label to the reject area if the label is non-viable (Figures 5A-5E).

As to claim 38, wherein the moving step includes sliding an applicator head carrying the label by suction from a home position adjacent the application zone (down position in Figure 5E) to a reject position (the up position in Figure 5E) adjacent the reject area if the label is non-viable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Koch III whose telephone number is (571) 272-1230 (TDD only). If the applicant cannot make a direct TDD-to-TDD call, the



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applicant can communicate by calling the Federal Relay Service at 1-866-377-8642 and giving the operator the above TDD number. The examiner can normally be reached on M-Th 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



George R. Koch III  
Patent Examiner  
Art Unit 1734

GRK  
5/24/2004